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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,171	11/09/1999	ANDREAS BLECKMANN	BEIERSDORF59	6227

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

2,6,10

Office Action Summary

Application No.

09/436,171

Applicant(s)

BLECKMANN ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-5, 7-9, and 11 are pending. The amendment filed 1/7/03, Paper No. 20, amended claims 1, 5, 9, and 11.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 1/7/03 (Paper No. 20) to the rejection of claims 1-5, 7-9 and 11 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

Applicant's amendment to the claims are sufficient-in-part to overcome the 35 USC 112 rejection in the previous Office Action. See below for the 112 rejection maintained.

112 Rejection Maintained

The rejection of claim 1 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 6/7/02, Paper No. 18, and those found below.

Regarding the phrase "condensation products of polyglycols and amines", Applicant argues, "Each of the terms in the phrase have a definitive meaning within the art and as such one of ordinary skill in the art would be able to contemplate the scope of compounds defined by the term". This argument is not persuasive. While the terms "condensation reaction", "polyglycol", and "amines", can be defined, this phrase is still vague and indefinite, as the Applicant does not recite a condensation reaction between polyglycols and amines. Given the incredible number of polyglycols and amines, it is impossible for one of ordinary skill in the art to be apprised of the "products" encompassed by this phrase.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. (WO 98/17232) in view of Dupuis et al. (6,338,858) in further view of Yoneyama et al. (5,015,469).

Schreiber et al. teach water-in-oil emulsions comprising 30-85% of an aqueous phase, and preferably 1-20% of a lipid phase, and a surface active substance of formula (I) of the instant invention. PEG-30 dipolyhydroxystearate is disclosed a surface-active substance. Oils disclosed include branched and unbranched hydrocarbons. The reference lacks cationic polymers and preferred oils. See pg. 4-15; pg. 17; pg. 19-40.

Dupuis et al. teach aqueous solid topical compositions. Water-in-oil emulsions are disclosed as cosmetic forms. Cationic polymers, comprising 0.001-5% of the compositions, are disclosed as conditioning agents for use in the compositions. Specifically disclosed as a cationic polymer is JR 400, wherein JR 400 is polyquaternium-10. See Col. 1, lines 1-30; Col. 5, lines 51-57; Col. 7, lines 59-Col. 8, line 20.

Yoneyama et al. teach water-in-oil emulsion type cosmetics comprising cationic surfactants. Hydrocarbon oils such as liquid paraffin, isopropyl myristate, waxes such as petrolatum, and silicone oils are disclosed as comprising the oil components. See abstract; Col. 5, line 5-Col. 6, line 2.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the cationic polymers of Dupuis et al. to the compositions of Schreiber et al. because a) Schreiber et al. and Dupuis et al. are both directed to cosmetic water-in-oil stick emulsions; b) Dupuis et al. teach that adding cationic polymers to such emulsions results in a conditioning effect; hence, the addition of cationic polymers for cosmetic purposes in the compositions of Schreiber et al. would be within the skill of one in the art because of the expectation of achieving a composition that imparts conditioning benefits to the skin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the liquid paraffin of Yoneyama et al. for the oils taught by the combined references because a) the combined references and Yoneyama et al. are both directed to water-in-oil cosmetic emulsions; b) the combined references teach isopropyl myristate and silicone oils for use in their oil phase and Yoneyama et al. teach liquid paraffin as interchangeable with isopropyl myristate and silicone oils in the oil phase of cosmetic water-in-oil emulsions; hence, the replacement of one for the other for cosmetic purposes would be within the skill of one in the art.

Response to 103 Arguments

Applicant argues, "It is also noted that Schreiber et al., when considering the reference as a whole, does not teach or suggest emulsions wherein the water content is at least 80% by weight or a oil phase of less than 20% by weight". This argument is not persuasive. The Examiner respectfully points out that on page 5, the aqueous phase is disclosed as comprising 30-85% of the w/o emulsion and on page 13, the oil phase is disclosed as comprising 1-20% of the composition.

Applicant argues, "Schreiber et al. disclosed 27 examples, none of which have the claimed water phase or oil phase ranges claimed by the applicants". This argument is not persuasive. First, the Examiner respectfully points out that the instant rejection is a 103, obviousness-type rejection, and not a 102, anticipation-type rejection. Second, the Examiner respectfully points out that it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 148 USPQ 507, 510; In re Lamberti, 192 USPQ 279, 280; In re Fracalossi, 215 USPQ 569, 570, In re Kaslow, 217 USPQ 1089, 1095.

Applicant argues, "Moreover, if the examiner is relying upon the preferred teachings to support her position with respect to oil phase content; the examiner cannot selectively discount Schreiber et al.'s preferred range of water content. It is also noted that Schreiber et al.'s lipid phase also comprises of wax components. . .As such, the preferred weight range of Schreiber et al.'s lipid phase is at least 2-40% by weight". This argument is not persuasive. First, the Examiner respectfully points out that she has not selectively discounted Schreiber et al.'s preferred range of water content. In the summary of their invention, Schreiber et al. teach their aqueous phase as comprising 30-85% water. Second, the Examiner respectfully points out that there appears to be no teaching on the amount of wax in Schreiber et al.'s composition, and it is thus unclear how a range of 2-40% was concluded. Furthermore, it is respectfully pointed out that a range of 2-40% encompasses "a content of lipids, emulsifiers and lipophilic constituents of less than 20% by weight, in each case based on the total weight of the preparations".

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Applicant argues, regarding Dupuis et al. and Yoneyama et al., “it is clear that they are different inventions from that of Schreiber et al. or the applicants’ invention and as such do not lend themselves to be combined with the Schreiber et al. reference nor is there a suggested motivation for making the appropriate substitution”. This argument is not persuasive. The Examiner respectfully points out that Dupuis et al, Yoneyama et al, and Schreiber et al, are all directed toward topical cosmetic compositions that can be in the form of water-in-oil emulsions, and that Dupuis et al., like Schreiber et al, is directed toward water in oil emulsions in the form of sticks.

Applicant argues, “Even if Dupuis et al. were directed to a water-in-oil emulsion, the solid state requirement as well as the viscosity requirements disclosed by Dupuis et al. teach away from an emulsion like that of the applicants invention which requires at least 80%”. This argument is not persuasive. First, the Examiner respectfully points out that Schreiber et al. also teach solid state compositions. Second, the Examiner respectfully points out that Dupuis et al. was relied upon for their teachings that cationic polymers are known conditioning agents that are can be added to cosmetic compositions to increase the conditioning effects of a composition that is applied to the skin.

Applicant argues, “When viewing various embodiments of Yoneyama et al.’s invention, it is clear that they do not disclose or intend to disclose water-in-oil compositions which require at least 80% by weight water phase”. This argument is not persuasive, as Yoneyama et al. is not relied upon to teach water-in-oil compositions or the percent weight of the water phase. It is respectfully pointed out that Yoneyama et al. is relied upon to teach that liquid paraffin is interchangeable with isopropyl myristate and silicone oils in cosmetic water-in-oil emulsions.

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Applicant argues, "The examiner concludes that the 'addition of cationic polymers for cosmetic purposes in the compositions of Schreiber et al. would be within the skill of one in the art". This argument is not persuasive, as it is not an accurate depiction of the motivation to combine the teachings of Schreiber and Dupuis. The above statement is merely a conclusion to the motivation. As previously stated, Schreiber and Dupuis both teach water-in-oil emulsions and compositions in the form of sticks, and Dupuis teaches cationic polymers as additives to such compositions, wherein cationic polymers are conditioning agent; thus, one of skill in the art would be motivated to add the cationic polymer of Dupuis to the composition of Schreiber because of the expectation of providing a composition that imparts a conditioning effect to the skin.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
January 21, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER 1/25/03